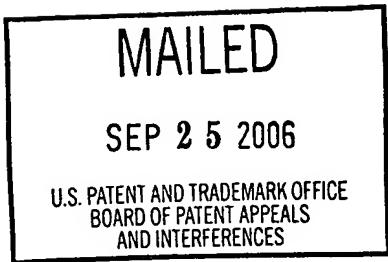


The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte STEVEN J. JOHNSON and KRZYSZTOF W. KORCZ



Appeal No. 2006-1347
Application No. 10/651,205
Technology Center 3600

ON BRIEF

Before BAHR, LEVY and HORNER, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the examiner's final rejection of claims 1-16, 18-21, 29, and 30. Claims 17 and 22 have been objected to as being dependent on a rejected base claim, and claims 23-28 have been allowed.

We affirm.

BACKGROUND

The appellants' invention relates to a brace assembly to support an outlet box. A copy of the claims on appeal can be found in the appendix to the appellants' brief.

The examiner relies upon the following as evidence of unpatentability:

Rinderer	4,967,990	Nov. 06, 1990
Harris <i>et al.</i> (Harris)	4,050,603	Sep. 27, 1977
Fast	5,040,316	Aug. 20, 1991

The following rejections are before us for review.

1. Claims 1, 3, 5, and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rinderer.
2. Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rinderer.
3. Claims 4, 8-16, 20, 21, 29, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rinderer in view of Harris.
4. Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rinderer in view of Fast.
5. Claims 18-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rinderer in view of Harris and Fast.

Rather than reiterate in detail the conflicting viewpoints advanced by the examiner and the appellants regarding this appeal, we make reference to the examiner's answer (mailed June 3, 2005) for the examiner's complete reasoning in

support of the rejection and to the appellants' brief (filed April 8, 2005) and reply brief (filed August 3, 2005) for the appellants' arguments.

OPINION

In reaching our decision in this appeal, we have carefully considered the appellants' specification and claims, the applied prior art, and the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations that follow.

Rejection of claims 1, 3, 5, and 7 under 35 U.S.C. § 102(b)

In the rejection of independent claim 1, the examiner has determined that Rinderer discloses all of the elements of the claim. Specifically, the examiner found that Rinderer shows a brace assembly for supporting an outlet box comprising a brace (21) having a base and mounting surfaces (51) extending from the base at an angle greater than 90 degrees, as shown in Figure 2. (Examiner's Answer, p. 3). The examiner contends that the brace assembly of Rinderer provides a compression fit between the studs, and that the strength of such fit would depend on the distance between the studs. (Examiner's Answer, p. 6).

The appellants agree that Rinderer shows a brace assembly including a brace with base and mounting surfaces that extend from the base at an angle greater than 90 degrees. The appellants argue, however, that Rinderer does not show a mounting surface adapted to create a compression fit with the support when installed. (Appellants' Brief, p. 10). The appellants argue that because the mounting surfaces (51) of Rinderer are not shown in contact with the supports (S)

when the brace assembly is installed, a compression fit is not created during installation, and there is no disclosure or suggestion in the Rinderer patent to create such a compression fit. (Appellants' Brief, p. 10). The appellants further characterize the portion of claim 1 directed to creating a compression fit as "functional language" and contend that the examiner does not appear to have considered this functional language in his rejection. (Appellants' Brief, p. 11).

While we agree with the appellants' characterization of the portion of claim 1 directed to creating a compression fit as "functional language," we disagree that this language is a sufficient basis for patentability. To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. *See Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir. 1997). There is no dispute that the structural limitations recited in claim 1 are all found in the Rinderer reference. Specifically, Rinderer discloses a brace assembly to support an outlet box having "a brace member adapted to be installed between first and second support members, said brace member having a base," "a first mounting surface extending from said base at a first end of said brace member," and "said first mounting surface forming a first angle greater than 90 degrees with said base."

Although Rinderer does not describe using its brace assembly to provide a compression fit between the studs, the absence of a disclosure relating to function does not defeat the examiner's anticipation rejection. "It is well settled that the recitation of a new intended use for an old product does not make a claim to that old

product patentable.” *In re Schreiber*, 128 F.2d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (holding Schreiber’s claimed dispensing top for popcorn designed to allow several kernels of popped popcorn to pass through at the same time to be anticipated by a prior art patent disclosing a spout used for dispensing oil from oil cans); *see also In re Swinehart*, 439 F.2d 210, 213-14, 169 USPQ 226, 229 (CCPA 1971) (“[I]t is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art.”). The appellants’ contention that their brace assembly is used to provide a compression fit does not have patentable weight if the structure is already known. *See Schreiber*, 128 F.2d at 1477, 44 USPQ2d at 1431.

We find that the Rinderer brace inherently provides a compression fit between the studs. The structure of the Rinderer brace assembly is identical to the claimed brace assembly. The mounting surface extends from the base at an angle greater than 90 degrees such that the distance between the studs dictates the strength of the compression fit provided by the brace assembly. As such, all of the elements of claim 1 are found in Rinderer, either expressly or under the principle of inherency, and the claim is thus clearly anticipated. Accordingly, we sustain the rejection of claim 1.

Dependent claim 3 further recites that the first mounting surface has a first fastener hole. The appellants contend, without providing specific arguments in

their appeal brief, that Rinderer does not disclose or suggest a fastener hole in the first mounting surface (51).¹ (Appellants' Brief, p. 14).

We find that Rinderer discloses fastener holes (55) in the mounting surface (51) as shown in Figure 4. Specifically, Rinderer describes that the extensions (51) have fold lines (FL1 and FL2) so that the brace can be adjusted to accommodate electrical boxes of different depths. As shown in Figure 4, if a relatively deep box (B) is to be attached, the extensions (51) are bent at the first fold line (FL1) to form fastening flaps (53). In this case, the portion of extension (51) between first fold line (FL1) and second fold line (FL2) lies adjacent to the side surface of support (S) and, as such, fastening holes (55) are located in the mounting surface (51). (Rinderer, col. 4, lines 39-56).

The appellants further argue that claim 3 is patentable because it includes the limitation of claim 1, and Rinderer does not disclose a compression fit. Since we have sustained the rejection of claim 1 as anticipated by Rinderer, the appellants cannot rely on this argument for patentability of claim 3. As such, we hold that Rinderer anticipates claim 3.

Dependent claim 5 recites a first flange that extends perpendicularly outwardly from the first mounting surface and is adapted to be received on a lower surface of the first support member. We agree with the examiner and find that

¹ The appellants are cautioned that a statement that merely points out what a claim recites will not be considered an argument for patentability of the claim. See M.P.E.P. § 1205.02(vii) (Rev. 3 August 2005). Nonetheless, in the present case, we treated the claims as separately argued in our decision.

Rinderer discloses a flange (53) that extends perpendicularly outwardly from the mounting surface (51) and is adapted to be received on a lower surface of support (S). (Rinderer, col. 4, lines 29-36 and Figure 2). As such, we hold that Rinderer anticipates claim 5.

Dependent claim 7 recites a second mounting surface that extends from a second end of the brace member and forms an angle greater than 90 degrees with the base and is adapted to create a compression fit with a support member when installed. Figure 2 of Rinderer clearly shows two mounting surfaces (51), one on either end of brace member (21). Further, for the same reasons discussed for claim 1, Rinderer inherently discloses that the second mounting surface provides a compression fit with the support (S) when installed. As such, we hold that Rinderer anticipates claim 7. Accordingly, we sustain the rejection of dependent claims 3, 5, 7 as being anticipated by Rinderer.

Rejection of claim 2 under 35 U.S.C. § 103(a)

Claim 2 depends from claim 1 and further recites that the angle between the first mounting surface and the base is approximately 94 degrees. The examiner has determined that this claim is obvious in view of Rinderer because Rinderer clearly shows an angle greater than 90 degrees and to make the angle at approximately 94 degrees is an obvious matter of engineering choice. (Examiner's Answer, p. 3). The appellants rely on their argument for patentability of claim 1, urging that claim 2 is patentable, because Rinderer does not show providing a compression fit. (Appellants' Brief, p. 14). The appellants further argue that claim 2 is not anticipated or rendered obvious by Rinderer because it recites an angle of

approximately 94 degrees. (Appellants' Brief, p. 15). The appellants, however, do not provide any evidence as to the criticality of making the angle between the first mounting surface and the base approximately 94 degrees, nor do they provide any evidence showing that the use of an angle at 94 degrees would result in a difference in function or give unexpected results over the obtuse angle shown in Rinderer. As such, we agree with the examiner that providing an angle of approximately 94 degrees between the first mounting surface and the base would have been obvious.

Haynes Intern., Inc. v. Jessop Steel Co., 8 F.3d 1573, 1577 n.3, 28 USPQ2d 1652, 1655 n.3 (Fed. Cir. 1993) ("[W]hen the difference between the claimed invention and the prior art is the range or value of a particular variable, then a prima facie rejection is properly established when the difference in range or value is minor"), citing *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990); and *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985). Accordingly, we sustain the rejection of claim 2.

Rejection of claims 4, 8-16, 20, 21, 29, and 30 under 35 U.S.C. § 103(a)

The examiner has determined that Rinderer discloses all of the elements of claims 4, 8-16, 20, 21, 29, and 30, except for an adjustable brace assembly. The examiner relies on Harris to show a brace assembly for securing an outlet box to supports, comprising telescopic adjustable members each having a mounting surface with a fastener hole and prongs to further secure the brace to the supports.

(Examiner's Answer, p. 4). The examiner found,

It would have been obvious to one skilled in the art at the time the invention was made to have made the brace assembly shown by Rinderer with telescopic brace members and the mounting surface with prongs to facilitate the use of the device. The telescopic brace members would permit easier storage, transportation, handling and more versatility of the brace member (since it can adjust its length to different distance between the supports). (Examiner's Answer, p. 4).

The appellants rely on their argument that Rinderer fails to disclose or suggest a compression fit between the first mounting surface and the support, and they argue that Harris fails to cure this deficiency. (Appellants' Brief, pp. 13-14).² We have found that Rinderer inherently discloses providing a compression fit, and we thus sustain the rejection of claims 8 and 29 for the same reasons provided above for claim 1.

With regard to claims 9 and 10, the appellants argue that the combination of Rinderer and Harris does not teach or suggest "the fastener holes in the mounting surfaces." (Appellants' Brief, p. 14) For the same reasons provided above with respect to claim 3, we find that Rinderer discloses fastener holes in the mounting surfaces. As such, we sustain the rejection of claims 9 and 10.

² The appellants note that, like claim 1, independent claim 8 also recites a first mounting surface being adapted to create a compression fit by contacting a first support member when installed, and independent claim 29 similarly recites a first mounting surface substantially engaging the first support member when installed to create a compression fit therebetween.

With regard to claims 4, 11, and 12, the appellants argue that the combination of Rinderer and Harris does not teach or suggest “prongs extending outwardly from the mounting surfaces.” (Appellants’ Brief, pp. 14-15). We find that Harris clearly describes conventional pronged attachment elements (3b) at the ends of its bar hanger (3) and thus shows the claimed prongs extending outwardly from mounting surfaces of the brace assembly. (Harris, col. 3, lines 42-44 and Figure 1). As such, the combination of Rinderer and Harris renders the invention of claims 4, 11, and 12 obvious to one skilled in the art at the time of the invention. Accordingly, we sustain the rejection of claims 4, 11, and 12.

With regard to claims 13 and 14, the appellants argue that the combination of Rinderer and Harris does not teach or suggest “flanges extending outwardly and adapted to be received on a lower surface of the support member.” (Appellants’ Brief, p. 15). For the same reasons provided above with respect to claim 5, we find that Rinderer discloses flanges extending perpendicularly outwardly and adapted to be received on a lower surface of the support member. As such, we sustain the rejection of claims 13 and 14.

With regard to claims 15 and 16, the appellants argue that the combination of Rinderer and Harris does not teach or suggest “the mounting surfaces extending from the base at an angle of approximately 94 degrees.” (Appellants’ Brief, p. 15). For the same reasons provided above with respect to claim 2, we find that it would have been a matter of obvious engineering choice, in view of the disclosure in Rinderer of an angle greater than 90 degrees, to have made the angle to be approximately 94 degrees. As such, we sustain the rejection of claims 15 and 16.

With regard to claim 30, the appellants argue that the combination of Rinderer and Harris does not teach or suggest “a second mounting surface forming a second angle greater than 90 degrees to create a compression fit with a second support when installed. (Appellants’ Brief, p. 15). For the same reasons provided above with respect to claim 7, we find that Rinderer clearly discloses a second mounting surface forming an angle greater than 90 degrees and inherently discloses that the second mounting surface creates a compression fit with a second support when installed. As such, we sustain the rejection of claim 30.

The appellants did not separately argue the patentability of the remaining rejected dependent claims 20 and 21, except to state generally that these claims recite “additional features” that distinguish them over the prior art. (Appellants’ Brief, p. 14) Finding no separate basis for patentability of these dependent claims, we also sustain the examiner’s rejection of claims 20 and 21.

Rejection of claims 6 and 18-21 under 35 U.S.C. § 103(a)

The examiner has determined that Fast shows the use of score lines to remove a portion to adjust to a desired length. The examiner found that it would have been obvious to one skilled in the art at the time the invention was made to have provided the device shown by Rinderer (claim 6) or shown by the combination of Rinderer and Harris (claims 18-21) with score lines “to adjust the length of the mounting surfaces to facilitate the use of the device and its versatility.” (Examiner’s Answer, pp. 4-5). The examiner argues that Fast is analogous art because it pertains to a bracket and means for adjusting its length. (Examiner’s Answer, p. 7).

The appellants argue that Fast is non-analogous art because it pertains to product information display tags for use with support hooks, which is a different field of endeavor than brace assemblies for ceiling fans and fixtures. The appellants further argue that the problem being addressed by Fast is not reasonably pertinent to solving the problem associated with providing a brace assembly having adjustable mounting surfaces to accommodate various wall thicknesses when installing an electrical box. (Appellants' Reply Brief, p. 14).

The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* ("[I]t is necessary to consider 'the reality of the circumstances,' -in other words, common sense-in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor." *Id.* (quoting *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A.1979))).

In re Kahn, 441 F.3d 977, 986-87, 78 USPQ2d 1329, 1335-1336 (Fed. Cir. 2006).

We agree with the appellants that Fast is not in the field of the appellants' endeavor. The appellants' general field of endeavor is a brace assembly to support an outlet box. While Fast similarly relates to a support assembly, the assembly (10) of Fast is designed to be used with a support hook (32) to hold products. We turn

now to whether Fast is reasonably pertinent to the problem with which the appellants were concerned.

The court in *Kahn* described the proper way to define the problem with which the inventor was concerned, stating, “In considering motivation in the obviousness analysis, the problem examined is not the specific problem solved by the invention but the general problem that confronted the inventor before the invention was made.” *Id.* at 988, 78 USPQ at 1336. The court also notes, “[the non-analogous arts] test begins the inquiry into whether a skilled artisan would have been motivated to combine references by defining the prior art relevant for the obviousness determination.” *Id.* at 987, 78 USPQ at 1336.

The appellants argued that the problem facing the inventor was to provide a brace assembly having adjustable mounting surfaces to accommodate various wall thicknesses when installing an electrical box. We find that this definition of the problem is too narrowly-focused on the specific problem solved by the invention, rather than more broadly focused on the general problem that confronted the inventor before the invention was made. We find that the general problem that confronted the inventor before the invention was made was one of providing an adjustable mounting surface for a support.

Based on this definition of the problem, we find that the Fast reference is reasonably pertinent to the problem with which the appellants were concerned, because Fast similarly relates to means for providing an adjustable mounting surface for a support. Fast describes that the tag (10) has mounting portions (14, 16, and 18), which are connected to each other by transverse lines of perforations

(34, 36). The mounting portions can be torn away at the perforations to adjust the length of the tag. (Fast, col. 2, lines 35-41).

The Fast reference is directed to the same purpose as the claimed invention, *viz*, to adjust the point at which the support is mounted to the wall by providing adjustable mounting surfaces. *See In re Clay*, 966 F.2d 656, 659-60, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992) (“If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection.”) The specification describes that the purpose of the score lines (69 and 60) is “to allow a portion of the first mounting surface to be removed to obtain proper positioning of the brace assembly (11) for various wall thicknesses.” (Specification, page 6, para. [0032]). Similarly, the purpose of the perforations (34, 36) of Fast is to allow a portion of the mounting surface (14, 16, 18) to be removed to obtain proper positioning of the tag (10) for various suspension hook lengths. (Fast, col. 2, lines 42-49). As such, we find that Fast is analogous art to the claimed invention and is a proper reference on which to base a finding of obviousness.

The appellants do not otherwise contest the teaching, suggestion, or motivation to combine Fast with Rinderer and Harris. We agree with the examiner’s reasoning for the motivation in the art to combine these references.

With regard to claim 6, the appellants argue that even when combined, Fast does not cure the deficiency of Rinderer, in that neither reference teaches or suggests a compression fit between the first mounting surface and the support. (Appellants’ Brief, pp. 13-14). Similarly, the appellants argue that claims 18-21 are

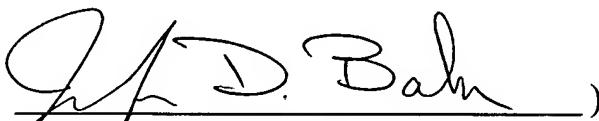
not obvious because Harris also does not cure the deficiency of Rinderer. We have found that Rinderer inherently discloses providing a compression fit, and we thus sustain the rejection of claims 6 and 18-21 for the same reasons provided above for claim 1.

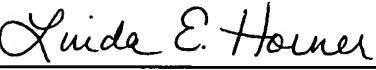
CONCLUSION

To summarize, the decision of the examiner to reject claims 1-16, 18-21, 29, and 30 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED


JENNIFER D. BAHR)
Administrative Patent Judge)
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STUART S. LEVY) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
)

LINDA E. HORNER)
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